REMARKS

The Examiner rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Nissl in view of Haber. Applicants respectfully disagree.

Claim 1 recites, "receiving a time stamp receipt at an outside agency, said time stamp receipt including identifying data associated with said document and a time indication ... [and] ...validating said time stamp receipt at said outside agency by comparing the time indication in said time stamp receipt to the current time." Thus, validation occurs on the time indication contained in the time stamp receipt received by the outside agency.

Nissl discloses a system and method for validating time. The Examiner asserts that Nissl verifies the time indication received with the time stamp receipt; however, scrutiny reveals otherwise. The time subject to the validation process of Nissl is not the time indication in the time stamp receipt, but actually *the time that is used to time stamp the data*. Nissl discloses,

> [T]he present invention resides in a method for sealing digital data, whereby the digital data is provided with a time stamp of an internal time signal of an internal clock. The method includes the steps of receiving and evaluating an internal broadcast or a cable signal of an external time source, from which a standard time can be derived, comparing the standard time with the internal time signal of the internal clock, time stamping the digital data, if a time difference between the internal and external time signals lies within a given tolerance range, and encrypting the time-stamped digital data.

Nissl, col. 4, ln. 57 – col. 3, ln. 6 (emphasis added). Nissl compares two times against each other to compute a difference. One time is a "standard time" derived from the signal of an external source, and the other time is the current time provided by an internal clock. Nissl then compares the two times to compute a difference. If the computed difference falls within a predetermined tolerance range (i.e., the two times are substantially similar to one another), Nissl uses the time to time stamp the digital data. In other words, Nissl does not teach validating a time indicator already in a time stamp, but rather, *validating a time that will be used as the time stamp*.

Haber also fails to teach or suggest this limitation of claim 1. Haber explicitly teaches *creating* the time indication independently of the author *after* receiving the request. *Haber*, col. 4, ll. 6-11. As such, whatever information is sent to the outside agency of Haber does not include a time indication. Because the outside agency in Haber does not receive a time indicator in the time stamp request from the requestor, it necessarily cannot *verify* the time indicator as required by claim 1. Moreover, verification of a document in Haber does not occur by comparing the time indication in the time stamp receipt to the current time. In contrast, verification with respect to the time stamp receipt occurs by fixing the time stamp receipt in a continuum of time. That is, Haber uses the time stamp receipts of documents received *before and after* the document being time stamped in the time stamp for the document. *Haber*, col. 3, ln. 68 – col. 4, ln. 33. Simply put, neither Nissl nor Haber teach or suggest each and every limitation of claim 1. Therefore, the § 103 rejection necessarily fails as a matter of law.

Additionally, the § 103 rejection also fails for another reason. Specifically, scrutiny reveals that Haber discourages a combination with Nissl. The fundamental goal of the method of Haber is to ensure a tamper-proof system that verifies the authenticity of a document. To achieve this goal, the method of Haber "*transfers control of the time-stamping step from the author* to an independent agent *and removes from the author the ability to influence the agent in the application of other than a truthful time stamp.*" *Haber*, col. 2, ll. 45-49 (emphasis added). This passage provides clear evidence that the outside agency of Haber *does not want* to receive a time indication from the requestor, and *does not need* a time indication from the requestor. Indeed, that the outside agency in Haber pointedly fixes the time stamp receipt in a continuum of time is further proof of this fact. In another embodiment, the outside agency uses a number of independent agents that add the time indication on behalf of the outside agency. Thus, even if one skilled in the art were to construe the patent to Nissl as the Examiner suggests, the references cannot be combined because Haber *teaches away* from receiving (and

thus, verifying) a time indication included in a time stamp receipt received from the requestor. As such, the § 103 rejection fails for this additional reason.

Therefore, neither Nissl nor Haber teach or suggest, alone or in combination, claim 1. Accordingly, Applicants respectfully request the allowance of claim 1 as well as its dependent claims 2-12.

The Examiner also rejected claims 13 and 19 under 35 U.S.C. § 103(a) over Nissl in view of Haber for the same reasons as those stated above for claim 1. However, both claims 13 and 19 contain language that requires the outside agency to operate on a time indication that is received from the requestor with the document time stamp. As such, both Nissl and Haber fail to teach or suggest, alone or in combination, claims 13 or 19 for reasons similar to those stated above with respect to claim 1. Accordingly, Applicants respectfully request the allowance of claims 13 and 19, as well as their respective dependent claims 14-18 and 20-30.

Finally, the Examiner provisionally rejected claims 1-30 under the judicially created doctrine of obviousness-type double patenting over claims 1-26 of co-pending Application Serial No. 09/458,928 issued to the same inventors. However, Applicants believe the rejection to be improper for at least two reasons. First, both applications claim patentably distinct subject matter. The instant application cryptographically binds a time stamp receipt if a time indication in the time-stamp receipt is valid. Validity is based on a comparison between the time indication in the time-stamp receipt and the current time. The '928 application also cryptographically binds a time stamp receipt, but uses additional information. Specifically, the '928 application computes the age of the time-stamp receipt, and uses that computed age in the binding process. Neither aspect is disclosed by the other application.

Second, Applicants note that both the instant application and the '928 application have the same filing date – December 10, 1999 – and thus, would have the same expiration date upon issue. Because both patents would have the same term, a terminal disclaimer would have

no effect. As such, Applicants respectfully request the Examiner withdraw the rejection and allow claims 1-30.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.

By:

Dated: September 1, 2004

Stephen A. Herrera
Registration No. 47,642

P.O. Box 5
Raleigh, NC 27602
Telephone: (919) 854-1844